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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR      | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|---------------------------|---------------------|------------------|
| 09/935,335      | 08/21/2001  | William John Zelinski JR. | TZIN-005            | 8129             |

7590

03/12/2003

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EXAMINER

NGUYEN, PHONG H

ART UNIT

PAPER NUMBER

3724

DATE MAILED: 03/12/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/935,335

Applicant(s)

ZELINSKI ET AL.

Examiner

Phong H Nguyen

Art Unit

3724

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_ 6) ☐ Other: \_\_\_\_

## DETAILED ACTION

### *Specification*

1. Claims 1 and 2 are objected to because of the following informalities:

Regarding claim 1, line 1; "of cutting" should be --for cutting--.

Regarding claim 2, line 1, "the spent water the water" should be --the spent water of the water--.

Appropriate correction is required.

### *Claim Rejections - 35 USC § 112*

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1 and 9 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for cutting seed potatoes, does not reasonably provide enablement for preventing the spread of disease. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make the invention commensurate in scope with these claims. Applicant has not shown that disease will absolutely be prevented using his method. For example, what if a potato is already diseased or infected before cutting? Also, what is to prevent bacteria or mold or virus from acting on the potato from the air after it has been cut? Or from contaminated water or from a contaminated conveyor?

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claims 1 and 9, it is not clear as set forth in the claims how disease is prevented and, therefore, the statement in the claims is without foundation. See paragraph 4 above.

#### ***Double Patenting***

6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

7. Claims 1-20 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-20 of U.S. Patent No. 6,321,484 B1 to Zelinski et al. in view of Maroney (5,528,967). Zelinski et al. teach a method of cutting seed potatoes by using beams formed by lasers. Maroney teaches a method of cutting fruit by using a beam formed by a water jet. It would have been obvious to replace one form of beam cutting for another and save on the expense needed for upkeep of the delicate machinery used with lasers.

***Claim Rejections - 35 USC § 102***

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 1-3, 9-12, and 14 are rejected under 35 U.S.C. 102(b) as being anticipated by Maroney (5,528,967). It is submitted that Maroney's fluid jet fruit slicer is capable of cutting potatoes.

Regarding claims 1 and 9, Maroney teaches a method for cutting grown agricultural products comprising the steps of sizing the to be cut grown agricultural products by a separator 138, supplying a chamber 48 with a water jet passing across, moving the grown agricultural products through water jet, and cutting the grown agricultural products with water jet. See Fig. 1, and col. 3, line 57 - col. 4, line 53.

Regarding claims 2, 3, 11, and 12, the spent water is directed from the water jet by stream collector tubes 62 and the termination points of the water jet are stream collector tubes 56. See Fig. 1

Regarding claim 14, Maroney teaches the pressure of the water jet is 40,000 psi which is in the claimed range since claim 14 does not have an upper limit. See col. 4, line 35.

### ***Claim Rejections - 35 USC § 103***

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 1-3, 9-12, and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Maroney (5,528,967) in view of Miles et al. (3,096,801).

To the degree it is argued that Maroney does not teach sizing, i.e., sorting, the patent to Miles et al. is additionally applied. Miles et al. teach sizing seed potatoes before conveying them to a cutting station.

Regarding claims 1 and 9, Maroney teaches a method for cutting grown agricultural products comprising the steps of conveying the to be cut grown agricultural products to the water jet cutting station, supplying a chamber 48 with a water jet passing across, moving the grown agricultural products through water jet, and cutting the grown agricultural products with water jet. See Fig. 1, and col. 3, line 57 - col. 4, line 53. Miles et al. teach sorter rollers 44 and 46 to size seed potatoes before cutting. See Fig. 2. It would have been obvious to further modify Maroney's cutting station by adding a sorter as taught by Miles et al. to size seed potatoes before they enter the cutting station since seed potato holders at the cutting station can hold certain potato's size.

Regarding claims 2, 3, 11, and 12, Maroney discloses the spent water is directed from the water jet by stream collector tubes 62 and the termination points of the water jet are stream collector tubes 56. See Fig. 1.

Regarding claim 14, Maroney teaches the pressure of the water jet is 40,000psi which is the claimed range.

12. Claims 4 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Maroney in view of Miles et al., as applied to claims above, and further in view of Drapper et al. (3,570,050). The combination of Maroney and Miles et al. does not disclose how to orient water jet nozzles to make multiple cuts on the seed potatoes. Drapper et al. teach using a plurality of water jets 72, 74, and 78 to make multiple cuts on a workpiece.

Therefore, it would have been obvious to further modify the combination of Maroney and Miles et al. by applying a plurality of water jets to cut a workpiece as taught by Drapper et al. to cut a seed potato into smaller pieces in less time.

### *Conclusion*

13. It is noted that the inventor of the instant application is one of the inventors of patent number 6,321,484. Patent number 6,321,484 was not mentioned in either applicant's Specification or in the IDS. Applicant is reminded of his duty of disclosure under 37 CFR 1.56 which is set forth in the signed 37 CFR 1.63 declaration.

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Taner et al. (6,375,565 B1), Zelinski et al. (6,321,484 B1), Briggs (3,090,414), Spry (2,601,233), and Meyer (2,487,719) teach potato cutter of general interest.

Nielsen et al. (5,551,910) teaches using of multiple water jets of general interest.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Phong H Nguyen whose telephone number is 703-305-4989. The examiner can normally be reached on Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Allan Shoap can be reached on 703-308-1082. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9302 for regular communications and 703-872-9302 for After Final communications.



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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1148.

PN: *pn*  
March 10, 2003

*Allen*  
Allan N. Shoap  
Supervisory Patent Examiner  
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